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APPLICATION NO. 09/732,788

FILING DATE 12/11/2000

FIRST NAMED INVENTOR Masayuki Kondo

ATTORNEY DOCKET NO. Q62242

CONFIRMATION NO. -2735 -

7590

10/02/2002

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EXAMINER

NGUYEN, THUKHANH T

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/732,788	KONDO, MASAYUKI
	Examiner	Art Unit
<u>'</u>	Thu Khanh T. Nguyen	1722
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status		
1) Responsive to communication(s) filed on <u>09 July 2002</u> .		
2a)⊠ This action is FINAL . 2b)□ Thi	s action is non-final.	
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. Disposition of Claims		
4)⊠ Claim(s) <u>1 and 2</u> is/are pending in the application.		
4a) Of the above claim(s) is/are withdrawn from consideration.		
5) Claim(s) is/are allowed.		
6)⊠ Claim(s) <u>1-2</u> is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) are subject to restriction and/or election requirement.		
Application Papers		
9) The specification is objected to by the Examiner.		
10) The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.		
If approved, corrected drawings are required in reply to this Office action.		
12)☐ The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) All b) Some * c) None of:		
1. Certified copies of the priority documents have been received.		
2. Certified copies of the priority documents have been received in Application No		
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 		
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).		
a) The translation of the foreign language provisional application has been received.		
15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)	. □	(DTO 440) Paran No.()
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) 🔲 Notice of Informal F	(PTO-413) Paper No(s) Patent Application (PTO-152)



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DETAILED ACTION

Drawings

1. In order to avoid abandonment, the drawing informalities noted in Paper No. 5, mailed on April 02, 2002, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper. The Applicant has indicated in the letter that the corrected Figures 4A and 4B have been submitted, however, the copy of the drawings are not found. Please resent those drawings.

Claim Rejections - 35 USC § 103

- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claims 1-2 are again rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Figs. 4A. and 4B) in view of Saito (5,620,711).

The admitted prior art discloses a resin molding waterproofing apparatus comprising an upper mold (5) and a lower mold (6), which has an inner space provided with vertical side faces (7) and a bottom face defines a lower part of the molding cavity.

The admitted prior art fails to disclose a dome-like ceiling of the upper mold and has a selected curvature to be coincident with a curvature of an outer face of the terminal fitting.

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Saito discloses a mold for forming a waterproof cable comprising an upper mold and a lower mold (col. 3, lines 8-16), wherein the molds have a dome-like shape formed with curvatures (15, 17).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify the admitted prior art by providing a dome-shaped upper mold, which has curvatures as taught by Saito, because the curvature of the upper mold would form a product that has a rounded shape. Further, that Applicant should be noticed that there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See Eskimo Pie Corp. v. Levous et al., 3 USPQ 23 and In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

Response to Arguments

- 4. Applicant's arguments filed July 02, 2002 have been fully considered but they are not persuasive.
- 5. In response to applicant's argument that Saito does not disclose the advantage of the dome-like shaped as disclosed by the Applicant, the fact that the applicant has recognized another advantage that would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Further, the current claims 1 and 2 claim an apparatus in which the only different from the prior art is the dome shaped structure of the upper mold. It has been held that there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See Eskimo Pie Corp. v. Levous et al., 3 USPQ 23 and In re Dailey, 357 F.2d 669, 149



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USPQ 47 (CCPA 1966). Therefore, changing the shape of the upper mold would not render the claims patentable over the prior art.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 703-305-7167. The examiner can normally be reached on Monday-Thursday and on alternate Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh can be reached on 703-308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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TN

September 30, 2002

JAN H. SILBAUGH
SUPERVISORY PATENT EXAMINER
ART UNIT 1921

09/30/02